

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30, and 32 will have been amended and resubmitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Further, Applicant has revised the claims to more consistently refer to an e-mail address and to a default e-mail address to be more consistent with the presently disclosed invention.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents in the parent application, as set forth in the Official Action.

Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004, July 6, 2004 and March 3, 2005 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner rejected claims 1-21 under 35 U.S.C. § 112, second paragraph. The Examiner has rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of BEAK et al. (U.S. Patent No. 5,798,845) and MAEADA (U.S. Patent Publication No. 2002/0059362). The Examiner has further provisionally rejected claims 1-33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of co-pending Application No. 10/767,949 in view of BEAK et al. Additionally, claims 1-133 were provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over various claims of co-pending Application No. 10/767,767.

However, Applicant respectfully traverses the above rejections.

The Examiner rejected claims 1-21 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner indicated that claims 1, 6, 11, 16, 18 and 20 contain a term for which there is insufficient antecedent basis. By the present Response, Applicant has eliminated this term from the claims and has thus obviated the basis for the Examiner's rejection of any of the claims under 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of any of the claims under 35 U.S.C. § 112, second paragraph.

As noted above, Applicant has amended claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 and resubmitted the same for consideration by the Examiner. Applicant respectfully traverses the above rejection based on the pending

claims and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims. Accordingly, no prosecution history estoppel should arise from these amendments.

Applicant's claims 1-21 generally relate to an image data communication apparatus connected to an image data source and to a network. The image data communication apparatus transmits image data attached to an e-mail to a receiving apparatus through a server via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a memory that stores a default e-mail address and a panel that inputs an e-mail address of a user to the image data communication apparatus. The image data communication apparatus includes a controller that sets the default e-mail address into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. Further, the controller sets the e-mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel. The mail from command is utilized for a communication between the image data communication apparatus and the server. Thus, when an error occurs, the e-mail address set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server to the e-mail address set into the mail from command. Claims 22-33 recite related methods.

According to the features of Applicant's invention as recited in the various claims, depending on whether the default e-mail address or the e-mail address of the user is

set into the mail from command, when an error occurs a mail error message is returned from the server to whichever e-mail address is set into the mail from command. At least this feature in the various claimed combinations is not taught, disclosed nor rendered obvious by any of the references relied upon by the Examiner or by any proper combination of the references relied upon by the Examiner.

Regarding the rejection of claims 1-45 under 35 U.S.C. § 103(a), LEE et al. relates to a system in which individual users 10 can access the directory service 24 to obtain directory information about a large number of people and businesses (col. 2, lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 24 (col. 2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 24 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

However, LEE et al. does not disclose an image data communication apparatus which sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel, the mail from command being utilized for a communication between the image data communication apparatus and the server, whereby, when an error occurs, the e-mail address set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server to the e-mail address set into the mail from command.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has

transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely disclose a conventional reply mail.

On the other hand, and in stark contrast to LEE et al., the present invention recites an image data communication apparatus which sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel, the mail from command being utilized for a communication between the image data communication apparatus and the server, whereby, when an error occurs, the e-mail address set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server to the e-mail address set into the mail from command.

Further, in Lee et al., a reply to a sending e-mail is returned from the recipient to the sender, based on an e-mail address included in the "Reply-to" field. Thus, the "Reply-to" field is utilized for a communication between the sender and the recipient, but is not utilized for a communication between the sender and the server.

On the other hand, the present invention recites a mail from command which is utilized for a communication between the image data communication apparatus and the server. Thus, a mail error message is returned from the server. By the present amendment, Applicant has amended the pending claims to clarify the scope of the invention. The amendment is supported by, inter alia, paragraph [0035] of the specification.

Additionally, and independently of the above, LEE et al. does not in any manner deal with error messages, nor does LEE et al. deal with a default e-mail address.

Thus, the only similarity between LEE et al. and the present invention, as recited in the claims, is that they both relate to communication systems which include a memory and a panel. Further, LEE et al. does not disclose attaching image data to an e-mail as is also recited in Applicant's claims. In this regard, LEE et al. relates to a directory system somewhat like a white pages (column 2, line 35) and it is not clear why one would wish or be motivated to attach image data to such a directory service.

In this regard, the Examiner, in setting forth the rejection, has asserted that transmission of image data attached to e-mail is known. However, this does not in any way indicate that one would be motivated to modify LEE et al. to utilize this feature therein. The mere fact that attaching image data to an e-mail is known does not automatically teach the obviousness of modifying LEE et al. to include this feature. In other words, LEE et al. is a directory service with a privacy feature. LEE et al. does not disclose, teach or render obvious the essential features of Applicant's invention which relate to setting an e-mail address into a mail command which is used for communication between an image data communication apparatus and a server so that when an error occurs, the e-mail address set into the mail from command is utilized as the destination of a mail error message.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims are not disclosed in LEE et al. cited by the Examiner.

BEAK et al. relates to a facsimile system which prints a user's unique name at the top of the document received by a recipient. BEAK et al. also disclose the automatic dialing number "FF" as a default number.

However, BAEK et al. relates, not to an Internet facsimile apparatus, but to an ordinary facsimile apparatus. Thus, BAEK et al. do not disclose and thus cannot teach or render obvious at least a controller that sets the default e-mail address into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. The BAEK et al. also do not disclose at least a controller that sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the mail address of the user is input by the panel (i.e., as opposed to when the mail address of the user is not input by the panel).

On the other hand, the pending claims (e.g., claim 1) recite a controller that sets the default e-mail address into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. The pending claims also recite a controller that sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel.

In setting forth the rejection, the Examiner admitted that LEE et al. does not disclose a memory configured to store a default e-mail address. The Examiner however asserts that this feature is known and relies on BAEK et al. for this limitation. However, the Examiner, in discussing BAEK et al., notes that it refers to a default "number", not to a default e-mail address. In fact, and as noted above, BAEK et al. has no relationship to an e-mail communication system at all. BAEK et al. is merely directed to a conventional facsimile system. Thus, the default is a "telephone number" and accordingly, cannot possibly be inserted into the mail from command of an e-mail

because BEAK et al. does not deal with e-mails in any manner. BEAK et al. merely prints the default phone number on a page. BEAK et al. does not set a default "telephone number" into a mail from command as is required, inter alia, by the recitations of Applicant's claims.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims are not taught or disclosed in BEAK et al. cited by the Examiner. Claims 1-33 are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor BEAK et al. disclose the features recited in Applicant's claims 1-33, claims 1-33 are clearly distinguished over the combination of LEE et al. and BEAK et al.

Therefore, Applicant submits that even if one attempted to combine the teachings of LEE et al. and the teachings of BEAK et al. in the manner suggested by the Examiner, such a combination would fail to render Applicant's invention obvious, since such a combination would not include at least a controller that sets the default e-mail address into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel and sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the mail address of the user is input by the panel.

MAEDA relates to an image communication system in which the transmitting-side apparatus 1 transmits to the receiving-side apparatus 2 a capability request to determine the reception capability of the receiving-side apparatus 2, before an original is read (paragraph [0067]). The receiving-side apparatus 2 transmits a capability

response to the transmitting-side apparatus 1 (paragraph [0069]). The transmitting-side apparatus 1 receives the capability response from the receiving-side apparatus 2, reads the original within a range of the capability designated by the receiving-side apparatus 2 and transmits to the receiving-side apparatus 2 image data as an attachment file of an E-mail (paragraphs [0071] and [0089]). The receiving-side receives from the transmitting-side apparatus the attachment file of the E-mail (paragraph [0073]). When the attachment file cannot be processed at the receiving-side apparatus 2, the receiving-side apparatus 2 transmits to the transmitting-side 1 an image-processing confirmation message indicating that the processing has not been normally completed (paragraphs [0098] and [0099]).

Further, MAEDA teaches that when the receiving side fails to process the image file attached to the received e-mail, the receiving side informs the transmitting side that the receiving side cannot handle the image file attached to the received e-mail by using a telephone or by transmitting a reply e-mail to the transmitting side (paragraph [0003]).

However, MAEDA does not disclose a controller that sets the e-mail address of the user input by the panel into the mail from command of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel, the mail from command being utilized for a communication between the image data communication apparatus and the server, whereby, when an error occurs, the e-mail address of the user set into the mail from command of the e-mail is utilized as a destination of a mail error message, the mail error message being returned from the server to the e-mail address set into the mail from command. Rather, MAEDA merely discloses a transmitting-side apparatus 1 that generates an e-mail in a general way (paragraphs

[0088]-[0093]). Thus, MAEDA does not disclose the transmitting-side apparatus 1 that sets the mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached.

Further, in MAEDA, when the receiving-side apparatus 2 cannot process the attachment file, the receiving-side apparatus 2 transmits to the transmitting-side apparatus 1 an image-processing confirmation message indicating that the processing has not been normally completed. In other words, the image-processing confirmation message of MAEDA is utilized for a communication between the transmitting-side apparatus 1 and the receiving-side apparatus 2. Thus, MAEDA does not disclose the mail from command that is utilized for a communication between the image data communication apparatus and the server.

Further, in MAEDA, when the receiving side fails to process the image file attached to the received e-mail, the receiving side informs the transmitting side that the receiving side cannot handle the image file attached to the received e-mail by using a telephone or by transmitting a reply e-mail to the transmitting side (paragraph [0003]). In other words, MAEDA merely discloses a communication between the transmitting side and the receiving side. Thus, MAEDA does not disclose utilizing the mail from command for a communication (of an error message) between the image data communication apparatus and the server.

On the other hand, the present invention recites a mail from command which is utilized for a communication between the image data communication apparatus and the server, and a controller which sets the e-mail address of the user, input by the panel, into the mail from command of the e-mail to which the image data is attached. Thus, a

mail error message is returned from the server to the e-mail address set into the mail from command.

MAEDA merely discloses an error message but does not disclose an error message that is sent to the e-mail address that has been set into the mail from command of an e-mail. Nor does MAEDA relate to a default e-mail address. Accordingly, MAEDA can certainly not teach utilizing and setting a default e-mail address or a user e-mail address into the mail from command of the e-mail and using such selectively set e-mail address for the mail error message as recited in Applicant's claims.

Thus, the pending claims are clearly distinguished over MAEDA.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims are not taught or disclosed in MAEDA cited by the Examiner. Claims 1-33 are also submitted to be patentable over the Examiner's proposed combination. In particular, since none of LEE et al., BEAK et al. and MAEDA discloses the features recited in Applicant's claims 1-33, claims 1-33 are clearly distinguished over the combination of LEE et al., BEAK et al. and MAEDA.

Additionally, Applicant notes that the Examiner has not set forth any proper evidentiary support for his assertion of obviousness of the combination of LEE et al., BEAK et al. and MAEDA. The Examiner has merely asserted that the combination would be obvious. A mere assertion of obviousness, without any supporting evidence and motivation for the proposed combination, is inadequate under 35 U.S.C. § 103 to render a claim unpatentable.

Additionally, Applicant respectfully submits that there is no proper motivation for the modification of the teachings of LEE et al. and BEAK et al. by the teachings of MAEDA. In particular, LEE et al. is directed to a directory which enables a user to hide his address (i.e., not to reveal his or her address to a sender). BEAK et al. is directed to an ordinary facsimile system. In contrast, MEADA is directed to the receiving-side apparatus 2 which, when the receiving-side apparatus 2 cannot process the attachment file, transmits to the transmitting-side apparatus 1 a general reply e-mail or an image-processing confirmation message indicating that the processing has not been normally completed.

There is no motivation to select isolated teachings from these documents, which have diverse structures and functions, even though they are from the general field of electronic communications.

Regarding the provisional rejection under the judicially created doctrine of obviousness-type double patenting, Applicant notes that, neither the claims of the present application, nor the claims of the two copending application utilized by the Examiner in the above-noted rejections are in their final form (i.e., have not been indicated to be allowable by the Examiner). Thus, filing a terminal disclosure is submitted to be premature.

Moreover, there are significant and substantial differences between the claims of the present application and the claimed subject matter of the copending application proposed to be modified by the Examiner in view of BECK. In this regard, as noted before, and merely as an illustrative example, the BECK reference does not deal with e-mail addresses at all. Rather, BECK deals with phone numbers and, thus, cannot

render obvious a default e-mail address as recited in the claims of the present application.

Nevertheless, and in spite of the above deficiencies, Applicant has, merely in order to overcome the double-patenting rejection and to expedite the allowance of the claims in the present application, attached hereto an executed Terminal Disclaimer to render moot both of the Examiners provisional obviousness-type double-patenting rejections.

The attached Terminal Disclaimer includes a provision that any patent granted on the present application shall be enforceable only and during such a period that the patent is commonly owned with the patents to issue on the applications without forming basis for the rejections.

However, by the submission of such Terminal Disclaimer, neither Applicant nor the Assignee intends in any manner to acquiesce in the propriety of either the Examiner's obviousness-type double-patentable rejections. Moreover, the submission of such Terminal Disclaimer should not be taken as an indication that any obviousness-type double-patenting rejection is proper in the present application. Rather, Applicant is submitting the attached Terminal Disclaimer solely in order to render moot the Examiner's rejections and to obtain early allowance of the claims in the present application.

Applicant further wishes to make of record a personal interview conducted between Applicant's undersigned representative and Examiner Lee on January 25, 2005 in regard to co-pending Application No. 10/767,615. The above-noted interview was attended by the undersigned representative of Applicant's assignee as well as Mr.

Hiroshi Takahashi of Panasonic Communications Co., Ltd., the assignee of the present application.

Initially, Applicant wishes to thank Examiner Lee for his courtesy and cooperation in scheduling and conducting the above-noted interview. Applicant further wishes to thank the Examiner for his cooperative and positive attitude towards the interview and towards the invention defined in the present application.

During the above-noted interview, Applicant discussed the then outstanding objection and rejection in U.S. Patent Application No. 10/767,615.

During the above-noted interview, Applicant also noted for the Examiner that the present application is one of 15 continuation applications that all claim priority under 35 U.S.C. § 120 from parent U.S. Patent Application No. 09/461,402, which is now U.S. Patent No. 6,710,894 which issued on March 23, 2004.

Additionally, during the above-noted interview, Applicant presented the Examiner with a chart listing the 15 continuation applications and pointing out the differences between the subject matter to which the claims of each of the 15 continuations (as well as the parent) were directed. Applicant prepared and gave this chart to the Examiner to facilitate examination of all the continuation applications.

Applicant's representative also pointed out that since the subject matter of each of the applications is directed to a different aspect (or combination of aspects) of the present invention, Applicant does not believe that any type of obviousness type double patenting rejection is appropriate. However, Applicant respectfully requested that the Examiner consider the claims of all of these applications together to determine for himself whether a obviousness type double patenting rejection is appropriate.

Applicant further indicated that if the Examiner decides that such a rejection is indicated, he would consider filing a Terminal Disclaimer to overcome such rejection.

Additionally, during the above-noted interview, Applicant's representative discussed several of the documents cited in the Information Disclosure Statements filed in the present application. In this regard, Applicant noted and expressly directed the Examiner's attention to Japanese Laid-Open Patent Publication HEI 10-307769, that issued to the Assignee of the present application and to Japanese Laid-Open Patent Publication HEI 08-542326 to Matsushita Electric Industrial Co., Ltd.

Applicant pointed out that both of these documents relate to the general subject matter of returning an error message which is claimed in several of the co-pending and commonly assigned continuation applications discussed above.

An English language translation and an English language patent family member of the above-noted Japanese documents (filed together with the Information Disclosure Statement) were also brought to the Examiner's attention and portions of the English language translation and patent family member were noted to relate to return of an error message. The Examiner particularly noted portions of the translation and family member that discuss the feature of returning an error message.

Applicant further respectfully suggested that in view of the discussion of the subject matter of various ones of the continuation applications, it would be obviously efficient to conduct examination of these 15 applications within a short time period after the interview in the present application.

At the conclusion of the interview, Applicant's undersigned representative expressed his appreciation to the Examiner for taking the time out of his busy schedule

to conduct an extensive interview regarding the present application as well as regarding the co-pending applications. Applicant again thanks the Examiner for his courtesy as well as for his positive and cooperative nature as exhibited during the above-noted interview.

Applicant further wishes to make of record a telephone interview conducted on November 3, 2005 in co-pending Application No. 10/767,719. During the above-noted interview, Applicant's undersigned representative discussed the merits of the above-noted application, which, as has been previously pointed out to the Examiner, and as the Examiner is undoubtedly aware, is one of 15 continuations of parent Application No. 09/461,402, now U.S. Patent No. 6,710,894. During the interview, Applicant also noted that each of the above-noted continuations as well as the above-noted parent application are being examined by the same Examiner. During the above-noted interview, the Examiner indicated that he is aware of each of the applications and the various references of record therein. Also during the above-noted interview, Applicant's undersigned representative asked the Examiner to ensure that the record is complete in each of these 15 applications by cross-citing each of the references cited in any of these applications into each of the other applications. The Examiner agreed to do so and Applicant agreed to facilitate such cross-citation by periodically updating the references cited in these various applications by the Examiner.

Accordingly, attached to the present Response, Applicant is providing a PTO-1449 Form in which various references cited in recently issued Office Actions in various ones of these 15 continuation applications are listed. The Examiner is respectfully requested to initial the attached PTO-1449 Form to confirm consideration of these

documents. The Examiner is respectfully thanked for his cooperation in this matter which will enable the record in the present application to be complete and to accurately indicate that the Examiner has considered all of these references that were cited in individual ones of these applications with respect to the claims in each of the applications.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and resubmitted the same for reconsideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Hidehiko OGAWA



William Pieprz  
Reg. No. 33,630

Bruce H. Bernstein  
Reg. No. 29,627

February 28, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191